

**REMARKS**

This paper is being filed in response to the Office Action dated July 1, 2003. Applicants respectfully request reconsideration of the above-identified application in light of the amendments and remarks presented in the instant Amendment.

Claims 2-4, 8-15, 20-23, 25-27, 29-32, 43, 68-73, 75-78 and 80 were pending and subject to examination. Claims 2, 4, 8-15, 20, 21, 23, 25, 26, 29, and 77 are objected to as containing various informalities. Claims 3, 22, 27, 30-32, 43 and 78 are rejected under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Claims 68-73, 75, 76 and 80 are rejected under the first paragraph of 35 U.S.C. § 112 as failing to satisfy the written description requirement and also for lack of enablement.

Applicants herein amend Claims 2-4, 20, 22-23, 27, 30, and 43 as indicated. Support for the amendments to Claims 2-4, 20, 22-23, 27, 30, and 43 may be found in the specification, *inter alia*, on pages 61-70. Applicants therefore assert that these amendments do not constitute the introduction of new matter. Applicants also cancel Claims 68-73, 75, 76 and 80 without disclaimer or prejudice to the prosecution of the subject matter of these claims in subsequent divisional or continuation patent applications. Thus, Claims 2-4, 8-15, 20-23, 25-27, 29-32, 43, and 77-78 are pending subject to the entry of this amendment.

For reasons set forth below, Applicants respectfully request that the rejections be removed and these claims be allowed to issue.

**I. The Claims Are Not Objectionable**

Claims 2, 4, 8-15, 20, 21, 23, 25, 26, 29, and 77 are objected to as containing various informalities. Specifically, Claim 2 is objected to under 37 C.F.R. § 1.75(c) as a multiple

dependent claim failing to refer to other claims in the alternative. Claim 4 is objected as lacking a necessary article of language. Claim 20 is objected to for inclusion of the designator "(a)" for a distinct, optional step. Claims 8-15, 21, 23, 25, 26, 29, and 77 are objected to because they depend, either directly or indirectly, from Claims 2, 4, or 20.

In response, Applicants have amended Claims 2, 4, and 20 as indicated herein. Claim 2 has been amended to recite the claims from which it depends in the alternative. Claim 4 has been amended so that the phrase "is coding sequence of" has been replaced by "comprises the coding sequence of." The format of the sequence identifier has also been corrected. Claim 20 has been amended to replace the designator "(A)" with the designator "(b)" for the distinct, optional step of this method. Applicants assert that, with these amendments, the claims are no longer objectionable and respectfully request that the Examiner remove the objections.

## **II. The Claims Are Definite**

Claims 3, 22, 27, 30-32, 43 and 78 are rejected under 35 U.S.C. §112, second paragraph as indefinite for allegedly failing to particularly point out and distinctly claim the subject matter that the Applicant regards as the invention. Specifically, the Examiner alleges that:

- 1) the phrase "the coding sequence" in line 2 of Claim 3 lacks proper antecedent basis;
- 2) Claim 22 is indefinite because the method of Claim 21 does not produce a transgenic plant at step (a), and that Claim 22 can depend from Claim 21 only to the extent that it modifies or adds to the method steps of Claim 21;
- 3) the phrase "first-generation plant, plant seed or progeny plant" in lines 2-3 of Claim 27 lacks proper antecedent basis in Claim 25;

- 4) the phrase "step (b)" in Claim 30 is indefinite because Claim 29 does not have a step (b) and is not directed to a method.
- 5) Claims 31 and 32 are indefinite because they do not obviate the indefiniteness of Claim 30.
- 6) the phrase "transgenic first-generation plant or transgenic progeny plant" in line 2 of Claim 43 lacks proper antecedent basis in Claim 25;
- 7) Claim 78 is indefinite because it is unclear if the plant seed or progeny plant is transgenic;
- 8) Claim 78 also is indefinite because it is dependent upon Claim 22 and does not obviate the indefiniteness of Claim 22.

In response, Applicants amend Claims 3, 22, 27, 30, and 43 as indicated herein. Specifically, Claim 3 has been amended to provide proper antecedent basis for the phrase "coding sequence;" Claim 22 has been amended to expressly incorporate steps (a) and (b) of Claim 21 relating to the generation of the transgenic plant prior to the step of producing a transgenic seed from the transgenic plant; Claim 27 has been amended to indicate that "the first-generation plant, plant seed or progeny plant" is produced from the transgenic plant cell of Claim 25; Claim 30 has been amended to remove reference to Claim 29, which Applicants believe to be superfluous; and Claim 43 has been amended to indicate that the transgenic first-generation plant or transgenic progeny plant are produced from the transgenic plant cell of Claim 25. Support for these amendments may be found in the claims of the instant application as originally filed. Applicants assert that the claims, as amended herein, are clear and definite. Applicants, therefore, respectfully request withdrawal of this rejection.

**III. The Claims Satisfy the Written Description Requirement and Are Enabled**

Claims 68-73, 75, 76 and 80 are rejected under the first paragraph of 35 U.S.C. § 112 as failing to satisfy the written description requirement and also for lack of enablement. These rejections are maintained from the last Office Action mailed October 22, 2002 and in the face of Applicants' arguments in response filed on January 21, 2003. According to the Examiner, the specification adequately describes and enables polynucleotides encoding the amino acid of SEQ ID NO:2, but does not reasonably describe or enable the genus of polynucleotides having 70%-99% identity to SEQ ID NO:1 or encoding a GST subunit having a sequence as set forth in SEQ ID NO:2, but modified by up to about 30 conservative substitutions.

Applicants respectfully disagree with the Examiner's position regarding the sufficiency of the specification as support for pending Claims 68-73, 75, 76 and 80 for the reasons set forth in the response filed January 21, 2003. However, in order to advance the prosecution of this application and to achieve the earliest possible allowance of claims, and without conceding the merit of the Examiner's position, Applicants have cancelled Claims 68-73, 75, 76 and 80 without disclaimer or prejudice to the prosecution of the subject matter of these claims in subsequent divisional or continuation patent applications. Applicants, therefore, respectfully request the withdrawal of the rejections issued under the first paragraph of 35 U.S.C. § 112.

**CONCLUSION**

Applicants maintain that in view of the amendments and remarks made herein, the claims are in condition for allowance. A Notice of Allowance is earnestly solicited.

Applicants do not believe any fee is required for this filing. Nevertheless, the Commissioner is hereby authorized to charge any fees required for this submission to Deposit Account No. 02-4377. Two copies of this page are enclosed.

Respectfully submitted,



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